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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,448	04/07/2001	Eric Schneider		4744

24226 7590 11/29/2005

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/681,448	Applicant(s) SCHNEIDER, ERIC	
	Examiner Igor Borissov	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 23, 24, 26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 23, 24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 9/11/2005 is acknowledged and entered. Claims 20-22, 25 and 27 have been canceled. Claims 1-5, 7-13, 15, 18, 19, 2, 24 and 26 have been amended. New claims 28-32 have been added. Claims 1-19, 23, 24, 26 and 28-32 are currently pending in the application.

Examiner's statement

Newly submitted Claims 28-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- A. Claims 1-19, 23, 24, 26 drawn to a method for processing a telephone call initiated by a calling party and offering to said calling party a telephone number available for subscription, classified in class 705, subclass 1.
- B. Claims 28-32 drawn to a method of charging a subscriber for utility, classified in class 705, subclass 412.

Inventions A and B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention B has utility separate from that of inventions A such as charging a utility subscriber for services rendered. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or patentability requirements, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 28-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilles (US 6,137,873) in view of Trell (US 6,393,117).

Gilles teaches a computer-implemented method for processing orders for telecommunication services, comprising:

Independent Claims

Claims 1, 24 and 26. Given a preferred (by a customer) telephone number pattern, matching the available numbers to the requested pattern and returning to a customer over a network a list of available numbers that match the desired telephone number pattern (C. 11, L. 48-51). Examiner understands *returning to a customer a list of available numbers that match the desired telephone number pattern* as returning to a customer numbers, which are similar to the desired ones and easy to remember, thereby disclosing “mnemonic” feature. While Gilles teaches that various steps disclosed are not necessarily sequential, and that the Gilles invention is independent of the sequence in which the steps are completed (C. 6, L. 1-9), Gilles does not explicitly teach that the provider initiates communication regarding said numbers.

Trell teaches a telephoning method and system, wherein a subscriber is offered an additional telephone number from a list of available, unused telephone numbers, and wherein said *offering* step is initiated by a service provider over the network (column 1, lines 49-50; Claim 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gilles to include that said *offering* step for an additional

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telephone number is initiated by the service provider, as disclosed in Trell, because it would provide large economical advantage to telephone companies since unused telephone numbers become used and cause an increase call frequency, as specifically stated in Trell (C. 5, L. 45-49).

Dependent Claims

Claim 2. See reasoning applied to Claim 1.

Claim 3. Gilles teaches said computer-implemented method, thereby indicating the *automation* feature.

Claims 4-6. See reasoning applied to Claim 1.

Claims 7-10. Gilles teaches, that based upon provided by a customer a preferred telephone number pattern, matching the available numbers to the requested pattern and returning to a customer over a network a list of available numbers that match the desired telephone number pattern (C. 11, L. 48-51). Examiner understands *returning to a customer a list of available numbers that match the desired telephone number pattern* as returning to a customer numbers, which are similar to the desired ones and easy to remember, thereby disclosing "mnemonic" feature.

Claim 11-13. See reasoning applied to Claim 1.

Claim 14. Gilles teaches said computer-implemented method, wherein said calling party is a service provider (C. 3, L. 28-30).

Claim 15. See reasoning applied to Claim 1.

Claim 16. Trell teaches: receiving dialed digits identifying selected preferences (C. 2, L. 50-57).

Claim 17. Trell teaches: receiving speech from said calling party by operator (C. 5, L. 58-59).

Claims 18-19. Trell teaches said method, wherein the subscriber initiates additional phone number request before said additional phone number is determined (C. 2, L. 50-63).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quatse et al. (US 5,991,368) in view of Gilles.

Independent Claims

Claim 23. Quatse et al. (Quatse) teaches customer information announcement method, comprising: maintaining a database (list) of customers (C. 1, L. 51-52); receiving dialed digits from a calling party corresponding to a phone number (C. 3, L. 10-12); attempting to place a phone call connection from said calling party through the network to said phone number (C. 3, L. 13-16); determining that said phone number is one of a changed phone number (C. 3, L. 32-33); communicating with said calling party to offer additional information related to the telephone number entered (C. 5, L. 10-12).

Quatse does not specifically teach that said additional information includes notifying said calling party that said dialed phone number is available for subscription.

Gilles teaches: based upon customer's request, offering a customer over a network a list of available (for subscription) numbers that match the desired telephone number pattern (C. 11, L. 48-51).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Quatse to include notifying said calling party about available numbers for subscription, as disclosed in Gilles, because it would provide large economical advantage to telephone companies since unused telephone numbers become used thereby causing increase in revenue.

Examiner's Note

Examiner maintains that the effective date of the current application is 3/22/1999.

Response to Arguments

Applicant's arguments filed 9/11/2005 have been fully considered but they are not persuasive.

Claim Rejections under 35 USC 101 have been withdrawn.

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In response to applicant's argument that Gilles fails to disclose "mnemonic" feature, it is noted that Gilles does, in fact, teach this feature. Specifically, Gilles teaches that the customer is provided with a list of available for subscription telephone numbers which match the desired by the customer telephone number pattern (C. 11, L. 48-51). Examiner points out that providing available numbers that match the desired number pattern indicates that said provided available numbers are mnemonically related to the desired by the customer number.

In response to applicant's argument that Trell fails to disclose offering to a subscriber an additional telephone number from a list of available, unused telephone numbers, it is noted that Trell explicitly teaches said feature. Specifically, Trell teaches "providing to said at least one subscriber upon completed ordering operation a verbal/alphanumerical message related to allocated temporary telephone number" (C. 7, L; 45-47).

In response to applicant's argument that the prior art fails to disclose a provider initiated notification method, it is noted that Trell teaches offering the subscriber an additional telephone number from a list of available, unused telephone numbers, wherein said *offering* step is initiated by a service provider over the network (column 1, lines 49-50; Claim 1).

In response to applicant's argument that there is no suggestion to combine Quatse and Gilles, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both references relate to providing telecommunication services to the subscriber. The motivation to modify Quatse to include notifying said calling party

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about available numbers for subscription as disclosed in Gilles would be to provide large economical advantage to telephone companies since unused telephone numbers become used thereby causing increase in revenue.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
Art Unit 3639

A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, stylized loop at the end.

IB

11/25/2005